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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,860	10/06/2003	Don C. McCall	1159-0016D	3195

7590 11/09/2006
Steven W. Smith
7237 Birchwood Drive
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EXAMINER

JANVIER, JEAN D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 11/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/679,860

Applicant(s)

MCCALL ET AL.

Examiner

Jean Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-57 is/are pending in the application.
- 4a) Of the above claim(s) 45-48, 51-55 and 56-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 49 and 50 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) ☐ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413) |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) ☐ Information Disclosure Statement(s) (PTO/SB/08) | 5) ☐ Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) ☐ Other: ____. |

Response To Amendments

Newly submitted claims 45-48, 51-55 and 56-57, directed to an invention that is independent or distinct from the invention originally claimed for the above reasons.

Independent claim 45 (claims 45-48) recites a method of providing a first reward receipt, as a reward to a customer for purchasing a number of non-fuel products in a first visit, wherein the reward receipt having a bar code imprinted thereon indicating that the customer is entitled to a first amount of free fuel, a second reward receipt, as a reward to the customer for purchasing a number of non-fuel products in a second visit, wherein the second reward receipt having a bar code imprinted thereon indicating that the customer is entitled to a second amount of free fuel and scanning the first and second reward receipts at a fuel dispenser before the customer can dispense an amount of fuel equal to the first and second amounts of free fuel.

Independent claim 51 (claims 51-55) recites a method of determining if a customer has purchased fuel at a store a threshold number of times and providing the customer with a reward upon determining that the customer has purchased fuel at the store a threshold number of times.

Independent claim 56 (claims 56-57) recites a method of providing an incentive to a customer for purchasing non-fuel products at a store by providing the customer with an amount of free fuel as a reward for purchasing a preset amount of non-fuel products, providing an incentive to the customer for purchasing non-fuel products at the store by offering the customer a price-per-unit discount on fuel as a reward for purchasing a preset amount of non-fuel products and varying the price of the fuel to provide fuel at a lower price-per-unit to the customer with a membership card for the store.

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Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 45-48, 51-55 and 56-57 are being withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response To Applicant's Arguments

Applicant's arguments with respect to claimed invention have been considered but are moot in view of the new ground(s) of rejection.

Furthermore, although fuel has been priced and sold per unit, however, "providing a lower member price" or "discounting the fuel price", as featured in priority document or Provisional Application 60/039,007, filed on Feb 25, 1997, does not immediately imply that the lower price is applied on a per-unit or per-gallon basis (or the lower price is a price-per-unit discount on fuel). One can very argue that the discount or the lower price, as featured in the priority document, is a percentage discount or a dollar figure, such a \$1.00 discount, applied on the customer's fuel purchase. Moreover, although there is no enablement problem here, nonetheless there is a lack of disclosure as far as interpreting the lower price as a price-per-unit or price-per-gallon discount (PPU discount). Thus, the priority document or Provisional Application 60/039,007, filed under 119(e), does not clearly support providing a price-per-unit (PPU) discount on fuel to the customer. In addition, contrary to the Applicant's contention, providing a price-per-unit (PPU) discount on fuel to a customer, as opposed to providing a 10% discount or a \$1.00 discount on fuel to the customer, is not so obvious since the Applicant's has considered that element as a novel feature. Having said that, the present Application will not

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receive the effective filing date from the Provisional Application and hence, the Hissey's article is herein being admitted as prior art against the claims.

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not plausible and thus, the current **Office Action has been made Final.**

DETAILED ACTION

Specification

Priority Information

This application is a divisional of copending U.S. Patent Application No. 09/746,392, filed December 21, 2000, which is a continuation-in-part of U.S. Patent Application No. 09/542,178, filed April 4, 2000, now abandoned, which was a continuation of U.S. Patent Application No. 09/255,472, filed February 23, 1999, now U.S. Patent No. 6,321,984, which was a continuation-in-part of U.S. Patent Application No. 09/026,634, filed February 20, 1998, now U.S. Patent No. 6,112,981, which claimed the benefit of the filing date of U.S. Provisional Application No. 60/039,007, filed February 25, 1997.

Status of the Claims

Claims 26, 27, 34, 35, 40, 42 and new claims 43-44 have been canceled and newly added claims 45-57 are pending in the Application. However, only claims 49-50 are being examined

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because claims 45-48, 51-55 and 56-57 are being withdrawn from further prosecution as described above.

General Comments

Claim Objections

Claim 50 is objected to because of the following informalities-

Concerning claim 50, "crediting the account for..." should apparently be - -debiting the account for...--

Appropriate correction is herein being requested.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 49 and 50 are rejected under 35 U.S.C. 102(a) as being anticipated by Hisey, in **"Storming the store Card Gates", an article published in July 1997.**

Concerning claims 49-50, "Storming the store Card Gates", an article published in July 1997, to Hisey describes a credit card (customer's membership card) loyalty-based system

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wherein a retailer operates gas stations at many of his retail stores (hyper-marketing) and wherein when identified valued customers, carrying co-branded credit cards, swipe their cards via the gas pumps, the posted-street price per liter (price per gallon or PPU) rolls backward instantly and displays a discounted price per liter or price per gallon unique to the identified customers and wherein the difference between the posted-street price per liter and the rolled back displayed price per liter or price per gallon represents the actual instant discounted price per liter or price per gallon (PPU discount). It should be understood here that the identified customer's accumulated discounts are stored in database under the customer's account before the customer can fully or partially redeem the discounts for fuel and wherein, following a redemption process at a gas station, the customer's account created in the database is debited accordingly to reflect the redemption (account reconciliation).

(See at least page.85 under Instant Discount).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a second reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

10/26/06

JDJ

Jean D. Janvier

Patent Examiner

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**JEAN D. JANVIER
PRIMARY EXAMINER**

Jean D. Janvier